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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRIS PERSHING

Appeal 2017-003546
Application 13/385,606
Technology Center 2600

Before MAHSHID D. SAADAT, ALLEN R. MacDONALD, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–31. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Exemplary Claim

Exemplary claim 1 under appeal reads as follows:

1. A computing system for generating estimated wall area measurements, the computing system comprising:

at least one computer processor; and

a memory coupled to the at least one computer processor, the memory having computer executable instructions stored on the memory, that, when executed, cause the at least one computer processor to:

receive roof measurements of a building having a roof;

receive one or more measurements indicative of one or more distances between one or more reference points on the roof and a ground surface on which the building rests;

generate, based at least in part on the received roof measurements and the received one or more measurements indicative of the one or more distances between the one or more reference points on the roof and the ground surface, an estimated wall area measurement of the building; and

output a wall area measurement estimate report having the estimated wall area measurement of the building thereon, wherein the generated wall estimation report is provided for repair and/or constructing a structure of the building.

Rejections on Appeal

1. The Examiner rejected claims 1–31 under 35 U.S.C. § 101 as failing to recite patent-eligible subject matter.

2. The Examiner rejected claims 1–5, 8–10, 13–16, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brolafontaine, *Generating Exterior Walls From Roofs in Sketch (Part 1) – Xactimate* 27, Internet Archive Wayback Machine (March 9, 2015), (<https://web.archive.org/web/20150309011317/http://www.screenr.com/OkN>) (<http://www.screenr.com/OkN>) (herein “Brolafontaine”) and Kathryn Hatter, *How do I Figure Square Footage for Painting the Outside of a House?* SFGATE, 1–3 (<http://homeguides.sfgate.com/figure-square-footage-painting-outside-house-8721.html>) (last visited April 30, 2015) (“herein “Hatter”).

3. The Examiner rejected claims 6, 7, 11, and 17 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brolafontaine, Hatter, and Hoguet (US 2009/0160856 A1; published June 25, 2009).

4. The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brolafontaine, Hatter, and Pershing (US 2009/0132436 A1; published May 21, 2009).

5. The Examiner rejected claims 18–27, 30, and 31 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Pershing, Brolafontaine, and Hatter.

Appellant’s Contentions

1. Appellant contends that the Examiner erred in rejecting claims 1–31 under 35 U.S.C. § 101 because:

The Examiner has not even identified the alleged abstract idea of “estimating wall area” as a fundamental economic practice, a certain method of organizing human activity, or an idea “of

itself". The Office has also failed to provide any reasons at all why it would fall under one of these examples. For at least this reason, the Office has provided no support in making this allegation and thus ***fails to establish a prima facie case that the claims are for an abstract idea.***

. . . .

Furthermore, the claims are not directed to merely "estimating wall area". The Examiner insisting that all the claims are directed to merely "estimating wall area" ***incorrectly describes the claims at such a high level of abstraction and untethered from the language of the claims such that it ensures that the exceptions to § 101 swallow the rule.*** In *Enfish v. Microsoft Corp.*, . . . the Federal Circuit., disagreeing with the characterization of the patent claims by the lower court as merely directed to an alleged abstract idea of "storing, organizing, and retrieving memory in a logical table", concluded that "describing the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule". . . . As the claims in *Enfish* improve computerized database processes, ***the claims in the present case improve the technological process of computerized building estimation, which is not abstract.***

. . . .

Even if the claims were directly to an alleged abstract idea of "estimating wall area", ***they include additional elements that when considered in combination make each claim as a whole amount to significantly more than "estimating wall area" itself.*** As can be seen from the additional limitations in the claims, claims 1-31 are each directed to a specific way of estimating wall area, ***which is significantly more than just "estimating wall area".*** . . .

. . . .

. . . [T]he claims certainly do not recite the only possible method of estimating wall area. . . . Thus, if granted, the claims would not result in a monopoly on the idea of estimating wall

area. Accordingly, the claims are not directed to a building block of the modern economy or human ingenuity, ***and pose no risk of pre-empting estimating wall area in all possible fields.***

App. Br. 20–24 (Appellant’s emphasis and citations omitted, panel’s emphasis added); *see also* App. Br. 25–42; Reply Br. 2–10.

2. Appellant also contends that the Examiner erred in rejecting claims 1–31 under 35 U.S.C. § 103(a) because:

The rejections under 35 USC 103 are all flawed due to the Examiner’s erroneous reliance on Brolafontaine as if it were a prior art reference. The Examiner has failed to show this reference qualifies as prior art. The reference is a video posted to the web site www.screenr.com, ***which provides no indication of the year it first was posted.*** Based on printouts from the web archive Wayback Machine, ***the Examiner alleges this reference was posted on or before January 17, 2011. This is incorrect.*** The printout from the Wayback Machine web site provided by the Examiner showing this date ***is for a completely different video.*** The link to the Brolafontaine video is <http://www.screenr.com/OkN>. Note the web address has a capital “O”. However, as shown on the top of page 3 of the .pdf document provided by the Examiner, the link provided by the Wayback Machine is <http://www.screenr.com/okN> with a lower case “o”. Going to <http://www.screenr.com/okN> (with a lower case “o”) brings up a completely different video about contact management software. Not all web page links are case sensitive, but the links to [screenr.com](http://www.screenr.com) videos are case sensitive and the Wayback Machine apparently does not recognize this and thus provides the wrong [screenr.com](http://www.screenr.com) video when a query is made.

As further evidence that the printout from the Wayback Machine web site provided by the Examiner showing the January 17, 2011, date is for a completely different video, not only is the link not the same, the title is completely different, and the user name of the person who posted the video is different. In particular, the video on the Wayback machine has the title “LESS.js has changed my life” which clearly is not

“Generating exterior walls from roofs in Sketch (Part 1) - Xactimate 27” and was posted by a different user having a username “brianegan”.

App. Br. 42–43 (Appellant’s emphasis and citations omitted, panel’s emphasis added); *see also* Reply Br. 10–14.

Issues on Appeal

Did the Examiner err in rejecting claims 1–31 as failing to recite patent-eligible subject matter?

Did the Examiner err in rejecting claims 1–31 as being obvious?

ANALYSIS

Rejection under § 101

As to Appellant’s contention 1, we are not persuaded the Examiner erred. In *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court articulated the required analysis for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas (which are not patent eligible under 35 U.S.C. § 101) from patents that claim patent-eligible applications of these concepts. *Alice Corp.*, 134 S. Ct. at 2355. The first step in the analysis is to determine whether the claims at issue are directed to a patent-ineligible concept, such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application. *Id.*

With respect to the first step in the analysis, we agree with the Examiner that the claims are directed to estimating an area of a wall, which is a purely mental process that can either be done within the mind or using pen and paper, and, thus, is an abstract idea. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011); *see also Synopsys v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146–47 (Fed. Cir. 2016). Appellant’s argument that the claims are similar to the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) or the claims in *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) because the claims improve the technological process of computerized building estimation is not persuasive. Unlike the claims in *Enfish* and *McRO*, the claims in the present application fail to recite the technical details that describe the alleged improvement of the technical process of computerized building estimation. Instead, the claims merely recite the abstract idea of estimating a wall area along with generic computer terminology (e.g., “computer processor” “memory,” etc.). Thus, the claims are merely directed to the automation of manually measuring an area of a wall described in Appellant’s Specification (*see, e.g.*, Spec. 1:12–15) using a generic computer. Such an “improvement” is not a patentable improvement in computer technology.

With respect to the second step in the analysis, we agree with the Examiner that the claims do not recite any additional elements, either considered individually or in combination, that make the claims as a whole amount to significantly more than the abstract idea of estimating a wall area. Although Appellant recites various claim elements of various claims (*see, e.g.*, App. Br. 22), Appellant does not explain how the recited claim

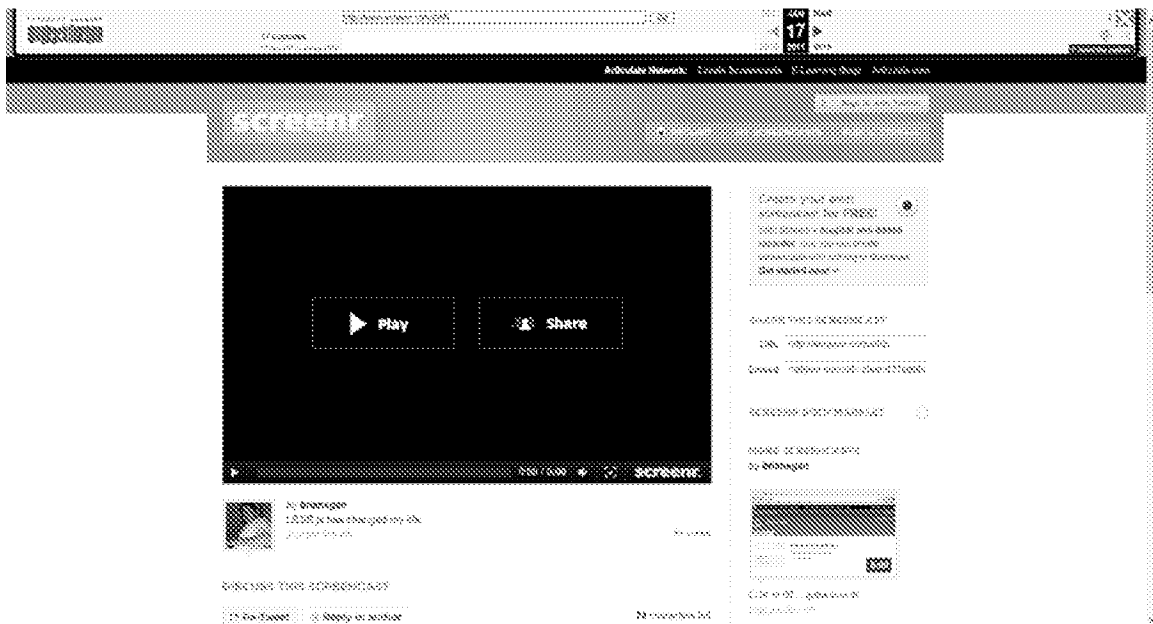
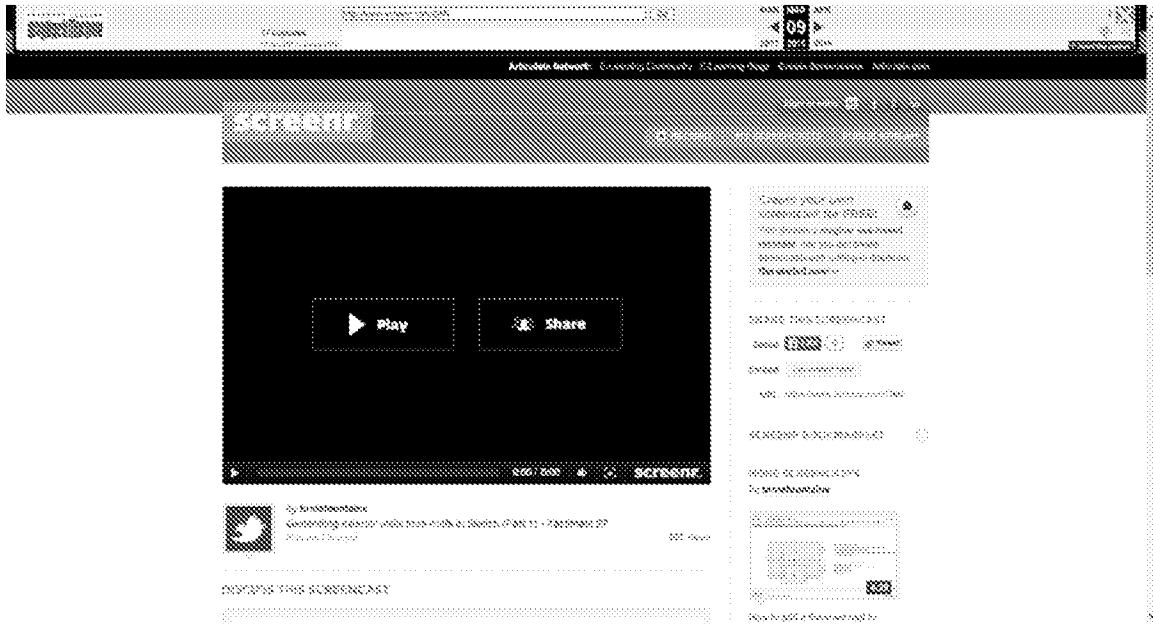
elements transform the claims from an abstract idea into patent-eligible subject matter. Further, the cited claim elements (e.g., “building having a roof” “measurements indicative of . . . distances between . . . reference points on the roof and a ground surface on which the building rests,” “wall area measurement . . . report having the estimated wall area measurement,” and “provided for repair and/or constructing a structure of the building”) merely describe well-understood, routine, and conventional concepts and activities previously known in the field of building measurements.

Regarding Appellant’s argument that claims do not preempt all methods of estimating a wall area, this argument is not persuasive, as the Federal Circuit has made clear that “the absence of complete preemption does not demonstrate patent eligibility” of a claim. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). We have considered Appellant’s other arguments regarding the patent-eligibility of the claims (*see* App. Br. 25–42), and we are not persuaded by them either. Accordingly, we sustain the rejection of claims 1–31 under 35 U.S.C. § 101.

Rejection under § 103

As to Appellant’s contention 2, we are persuaded the Examiner erred. We agree with Appellant that the web archive “Internet Archive Wayback Machine” shows that the earliest indexed capture of the Brolafontaine reference is actually dated March 9, 2015, which is after the effective filing date of the present application (i.e., February 3, 2012). All earlier captures that are indexed using the index “http://www/screenr.com/OkN” (including the indexed capture dated January 17, 2011) are captures of a different video, as evidenced by the different title and different user name. This is illustrated in the following screenshots reproduced below, where the first

screenshot is a screenshot of the indexed capture dated March 9, 2015, and the second screenshot is a screenshot of the indexed capture dated January 17, 2011:



First screenshot of the indexed capture (dated March 9, 2015) and the second screenshot of the indexed capture (dated January 17, 2011).

Thus, we conclude that the Examiner has failed to show that the Brolafontaine reference was available as prior art under 35 U.S.C. § 103(a).¹ Accordingly, we do not sustain the rejections of claims 1–31 under 35 U.S.C. § 103(a).

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1–31 as failing to recite patent-eligible subject matter under 35 U.S.C. § 101.

(2) Appellant has established that the Examiner erred in rejecting claims 1–31 as being unpatentable under 35 U.S.C. § 103(a).

(3) Claims 1–31 are not patentable.

DECISION

We affirm the Examiner’s rejection of claims 1–31 as failing to recite patent-eligible subject matter under 35 U.S.C. § 101.

We reverse the Examiner’s rejections of claims 1–31 as being unpatentable under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

¹ We note that manuals of the “Xactimate 27” software product described in Brolafontaine appear to be available online at <https://www.xactware.com/en-us/solutions/claims-estimating/welcome/#>.